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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,893	03/15/2001	Masahisa Kosaka	8071.0002	3498

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EXAMINER

GORR, RACHEL F

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/805,893

Applicant(s)

KOSAKA, MASAHISA

Examiner

Rachel F. Gorr

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 11, 13, 16, 18 and 20-25 is/are rejected.
- 7) ☒ Claim(s) 5-7, 10, 12, 14, 15, 17 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 8, 9, 11, 13, 20, 21 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Amagai.

Amagai discloses a transparent lens and the process for making it from a polythiol, an episulfide and a polyisocyanate. In example 5 of table 1, he shows a ratio of SH /NCO of 3.4, and he shows using polythiol bis (mercaptoethyl) sulfide. In col. 5 he discloses polyisocyanates with and without sulfur, and in lines 36-38, he shows that mixtures of polyisocyanates can be used. In col. 9, line 38, he discloses using bis (mercaptomethyl) dithian. In Table 1, all the examples show refractive index values between 1.65 and 1.76.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amagai in view of Keita.

5. Amagai discloses the process and lens of the claims (see above rejection). He differs from claims 16 and 18 by not specifically listing dicyclohexylmethane diisocyanate.

6. Keita discloses lens compositions comprising polyisocyanates, episulfides and other components, such as polythiols (col. 2, lines 21-26). At the top of col. 4, he discloses dicyclohexylmethane diisocyanate (lines 6-7) among a list of other polyisocyanate.

7. It would have been obvious to one of ordinary skill in the art at the time the invention was made for Amagai to use dicyclohexylmethane diisocyanate because Keita shows that it can be used for similar lens compositions as well as the other polyisocyanates listed by Amagai.

8. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amagai in view of Taniguchi.

9. Amagai discloses the invention of the claims (see the above rejection). He differs from these claims by not disclosing coating the lens.

10. Taniguchi discloses three layers of coatings for plastic lenses comprising a silane first coat, a second coat comprising an inorganic antimony compound, and a top coat of a fluoro/silicon material (col. 9, lines 14-39).

11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the lens of Amagai with the layers of coatings shown by Taniguchi in order to improve anti-glare, scratch resistance and weatherability properties per the teachings of Taniguchi (see abstract).

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12. Claims 5-7, 10, 12, 14, 15, 17 and 19 are objected to for depending on rejected claims.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel F. Gorr whose telephone number is 703-308-3608. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 703-308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

R. G.  
August 22, 2003

  
RACHEL GORR  
PRIMARY EXAMINER